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EXAMINER

LEE, PHILIP C

ART UNIT	PAPER NUMBER
2154	

DATE MAILED: 11/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/645,660

Applicant(s)

MENA, JESUS

Examiner

Philip C Lee

Art Unit

2154

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-16 are presented for examination.
2. It is noted that although the present application does contain line numbers in the specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.
3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the numbering of the claims must be consecutively beginning with the number next following the highest numbered claims previously presented, and the dependent claims cannot depend on the claim that has not been presented.

Misnumbered claims 15-17 have been renumbered 14-16 respectively.

Claim Rejections – 35 USC 112

4. Claims 3-7, 13 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a. The following terms lack proper antecedent basis:

- i. the identity – claim 3.
 - ii. the Internet – claim 13.
 - iii. the steps – claim 14.
- b. Claim language in the following claims is not clearly understood:
 - i. As per claim 3, line 3, it is uncertain whether the identity of the user refers to the information identifying a user in claim 2, line 3 [i.e. are they the same?].

Claim Rejections – 35 USC 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-3, 8, 10 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Kappel, U.S. Patent 6,144,988 (hereinafter Kappel).

8. As per claim 1,

one or more subscriber servers for collecting information identifying a user
(browser, figure 4; col. 5, lines 50-52; col. 6, lines 23-26).

one or more demographic databases (40, figure 4; col. 6, lines 28-30 and 54-59);
and

a hub server in operative communication with the one or more subscriber servers
and the one or more demographic databases (20, figure 4; col. 6, lines 23-30).

9. As per claim 2, wherein the hub server receives the information identifying a user from one of the subscriber servers and generates a unique key corresponding to the information identifying a user (col. 3, lines 1-7; col. 6, lines 60-col. 7, lines 5; col. 7, lines 26-40).

10. As per claim 3, wherein the one or more demographic databases communicate to the hub server demographic information about the user based on the identity of the user (col. 7, lines 41-58; col. 8, lines 9-12).

11. As per claim 8, wherein the unique key corresponds to values indexed by the one or more demographic databases (col. 3, lines 2-7; col. 6, lines 26-28, 30-38).

12. As per claim 10, wherein the unique key comprises a postal address (col. 7, lines 5-29).

13. As per claim 13, wherein

the one or more subscriber servers are coupled to the Internet (browser, figure 2;
col. 3, lines 1-2),

the one or more demographic databases are coupled to the Internet (40, figure 2;
remote server, col. 3, lines 4-5; col. 7, lines 41-44), and

the hub server is coupled to the Internet (20, figure 2; web server, col. 3, lines 4-
5).

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 9, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kappel.

16. As per claim 9 and 11-12, Kappel did not specifically detailing the unique key. However, Kappel taught that the unique key could be the type of information that can be standardized according to certain specifications (col. 7, lines 5-14). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include information that can be standardized according to certain specifications such as an email address, a Social Security

Number, or a TCP/IP address as the unique key in Kappel's system because this would enhance the field of use in their systems.

17. Claims 4-7 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kappel in view of Gerace, U.S. Patent 5,848,396 (hereinafter Gerace).

18. As per claim 4, Kappel taught the invention substantially as claimed in claim 3 above. Kappel did not teach analyzing the demographic information about the user. Gerace taught the system wherein the hub server, analyzes the demographic information about the user to calculate a score (col. 2, lines 46-53; col. 3, lines 16-20; col. 13, lines 9-20).

19. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Kappel and Gerace because Gerace's system for analyzing user data would improve the effectiveness of Kappel's system by allowing targeted marketing based on the performance report calculated from the demographic profiles of the user (Gerace, col. 2, lines 30-35).

20. As per claim 5, Kappel and Gerace taught the invention substantially as claimed in claim 4 above. Kappel further taught the hub server communicates the score to the one or more subscriber servers (col. 3, lines 13-19; 4a, 4b, 4c, figure 4; col. 6, lines 41-45).

As per claims 6 and 7, Kappel and Gerace taught the invention substantially as claimed in claim 5 above. Gerace further taught the system wherein the one or more subscriber servers use the score communicated by the hub server to selectively market products and services to the user (abstract; col. 2, lines 46-53).

21. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Kappel and Gerace because Gerace's system for analyzing user data would improve the effectiveness of Kappel's system by allowing targeted marketing based on the performance report calculated from the demographic profiles of the user (Gerace, col. 2, lines 30-35).

22. As per claim 14, Kappel taught the invention substantially as claimed comprising the steps of:

receiving from a subscriber server user-identifying indicia (col. 3, lines 1-2; 1a, 1b, 1c, figure 4; col. 6, lines 23-26);

generating from the user-identifying indicia a key which corresponds to values indexed by demographic databases (col. 3, lines 2-7; col. 6, lines 26-28, 30-35);
communicating the key to a demographic database (col. 3, lines 6-7; 2a, 2b, 2c, figure 4; col. 6, lines 30-35);

receiving from the demographic database demographic information relating to the user-identifying indicia (col. 3, lines 7-10; 3a, 3b, 3c, figure 4; col. 6, lines 35-38, 54-59); and

communicating the score to the subscriber server (col. 3, lines 13-19; 4a, 4b, 4c, figure 4; col. 6, lines 41-45).

23. Kappel did not teach generating a score from the demographic information relating to the user-identifying indicia. Gerace taught generating report from the demographic information relating to the user-identifying indicia (col. 2, lines 43-53; col. 13, lines 9-20).

24. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Kappel and Gerace for the reason set forth in claim 4 above.

25. As per claims 15 and 16, Kappel and Gerace taught the invention substantially as claimed in claim 14 above. Gerace further taught the step of the subscriber server determining whether or not to offer a user a product based on the score (abstract; col. 2, lines 46-53).

CONCLUSION

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yu et al, U.S. Patent 5,832,482, disclosed a method for using an iterative approach for mining causality rules.

Ran et al, U.S. Patent 6,209,026, disclosed a system for providing real-time information based on a user request.

Barrett et al, U.S. Patent 5,727,129, disclosed a system for providing a user information based on the user's past history of network usage.

Barrett et al, U.S. Patent 5,802,527, disclosed a data engine for providing real-time data enhancement on event records.

27. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (703)305-7721. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday.

29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng Ai An can be reached on (703)305-9678. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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30. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)350-6121.

P.L.


ZARNI MAUNG
PRIMARY EXAMINER